

Remarks/Arguments

Claims 1-59 are pending in the application. Claims 60-63 are withdrawn from consideration, as deemed drawn to an unelected species. Claims 33, 53, and 54 are amended. New claims 64 to 67 are added. No new matter is introduced.

Rejections Under 35 USC § 102

All claims have been rejected under 35 USC §102 as anticipated by Rodkin, USP 6581,065. There can be no prima facie case of anticipation unless it is shown that each and every limitation of a claim is found in the cited reference.

Rodkin operates primarily on webpages at the content server to annotate them with addresses, which may be dynamic addresses. Once the webpages are delivered to the user's web browser, character strings (key elements) in the webpages will have already been marked with static or dynamic addresses. Rodkin, for example, states:

"A Web surfer's browser 435 communicates with the content server 410 to access the on-line article with hypertext 415. The Web surfer clicks on (or otherwise selects) the hypertext in the on-line article 415 to launch CGI script 420, referred to as "Part A" of the Dynamic Decision Filter TM. Part A of the Dynamic Decision Filter TM. provides a relevant destination address for computer information 440. The Web surfer's browser 435 then communicates with a third party server 445, which delivers the relevant destination to the browser 435, e.g., in the form of the designated Web page."

Rodkin, Col 13, lines 11-20

Rodkin also teaches that if the content server does not store a discrete file, whatever is output must still occur "whenever the user activates a particular character string of the article to be annotated." Accordingly, this necessarily means that in the document presented to the user, there is some level of preexisting annotation associated with the character string for the user to interact with, which apparently calls the content server for a more complete annotation. Col 14, ln 63 to col 15, ln 6. In other words, in Rodkin, the recognition process that determines which

character strings will receive an annotation is determined *before* the document arrives at the user.

In contrast, the claimed inventions recite a process where recognition occurs in real-time as a user computer renders an electronic document. The recognition occurs by a computer other than the content provider's computer system--either by the user's computer or by a central computer system interacting with the user's computer.

The Rodkin system is analogous to having a house in which there are window frames in the walls. Each window frame represents a key element or character string. Each window frame may show a scene, which can change according to what's going on outside. However, once the Rodkin house is built, no more window frames may be added to the wall to open up new scenes not viewable from the original window frames. The claimed invention goes beyond this limited system of construction and allows additional window frames to be flexibly placed into the walls after the house is built and the occupants have moved in, affording the occupants more scenes of possible interest than what was originally there.

Turning generally to the independent claims, the rejections must be withdrawn because they do not give proper consideration to the recited roles and interactions of specific computer systems, as recited in the claims, and which enable the foregoing advantages. First, the Action fails to identify what in Rodkin is considered to specifically correspond to the specific computer systems recited in the claims. Because of this, the Action does not state a *prima facie* case or anticipation. Presumably, content server 410, central server 450, and user system 435 in Rodkin are considered analogous to the claimed central computer system, content provider computer system, and client computer system, respectively, as recited in the claims. Even under this presumption, there is no *prima facie* case of anticipation for the following specific reasons.

Rejections of Claims 1, 20, 22, 27, 33, 45, 48-49, and 53-54

Claim 1 recites that the central computer system interacts with the client computer system to invoke the central computer system to recognize key elements. The passage, col 12, lns 45-49, cited by the examiner makes no mention as to which computer system in its system of content server 410, central server 450, and user system 435 performs the recognition. In Rodkin, between the central server and content server, the content server is the only computer interacting directly with the client system—see, for example, Fig. 4, showing that user computer 435 is connected to content server 410. Rodkin expressly teaches that recognition and annotation is performed by the intelligent annotator 412, 520, which is on the content server 410, not the central server, as recited in the claims.

The Action asserts that col 11, lns 29-31 and 62-64 in Rodkin teach recognizing key elements in the document based on the key elements in the key elements list. In fact, the cited passages at col 11 merely say that the central server maintains a database with a master list of character strings and destination addresses; it does not say or imply that the central server is the system that uses the list to perform recognition. Again, this is the role of Rodkin's intelligent annotator 410/520, which is expressly described to be part of the content server 410. (See, for example, col 14-15, and Fig. 5). Accordingly, Rodkin does not disclose the system as arranged in claim 1, and cannot anticipate it.

To further emphasize the aforesaid limitations in Rodkin's teachings, new claim 64 is added, which is identical to claim 1, but with the additional language "and wherein the central computer system recognizes key elements in the document that were not previously recognized and/or annotated by the content provider providing the document to the client computer system." This claim is fully supported by the specification and no new matter is added (see, e.g., Example 2: Server-Based Annotation, page 33).

Claim 20 recites that a first computer system receives a web page corresponding to a web page presented to the user of a second computer system. The Action does not discuss this claim limitation whatsoever or identify anything in the prior art that would correspond to it. Therefore there can be no prima facie case of anticipation.

Claim 22 recites sending a key list from a remote computer system to a client computer system. The Action does not discuss this claim limitation whatsoever or identify anything in the prior art that would correspond to it. Therefore there can be no prima facie case of anticipation. In fact, Rodkin teaches only that the central computer system and content provider system interact with anything equivalent to a key element list; the client computer is not involved. (See col 11, lns 24-46; col 13, lns 42-51, for example.)

Claim 27 recites that a first computer system receives an electronic document, and a second computer, which knows the identity of the document (i.e., the central computer system), but which did not send the document to the first computer, sends annotation instructions to the first computer (i.e., the client computer). The Action does not discuss these claim limitations whatsoever or identify anything in Rodkin that would correspond to the sequence of steps and roles of each computer. In fact, in the Rodkin system, the user computer interacts only with the content server and not the central computer, and the content server is the one that provided the electronic document. While there are interactions between the content server and the central server, in those interactions the content server would be the source for providing the central server the electronic document, and therefore the claim limitation is not met, in case the examiner construes the content server and central server to be the first and second computers. Therefore there can be no prima facie case of anticipation.

To further emphasize the aforesaid limitations in Rodkin's teachings, new claim 65 is added, which is identical to claim 27, but with the language "on a first computer system, receiving an electronic document..." changed to "on a first computer system, receiving an

electronic document from the content provider computer system..."; and greater specificity as to which role each computer system has, namely "first computer" becomes "consumer computer", "second computer system" becomes "central computer system", and "central computer system" is added to the preamble.

Claim 33 is amended to emphasize certain patentable distinctions. The amendment does not introduce any new matter and is fully supported by the specification (see, e.g., pages 30-36.)

Claim 45 recites that the consumer computer receives code for performing annotation and recognition functions. The Action does not discuss this limitation specific to a consumer computer system. Rodkin teaches that annotation is performed by the content server, not the users computer system. Therefore, there can be no prima facie case of anticipation.

To further emphasize the aforesaid limitations in Rodkin's teachings, new claim 66 is added, which is identical to claim 45, but with the language "wherein the key list is stored on and used by the consumer computer system to recognize key elements in the electronic document that were not previously recognized and/or annotated by the content provider providing the document to the consumer computer system." The amendment does not introduce any new matter and is fully supported by the specification (see, e.g., pages 30-36).

Claim 48 recites that the central computer system interacts with the client computer system to invoke the central computer system to recognize key elements. The Rodkin passage, col 12, lns 45-49, cited in the Action makes no mention as to which computer system in its system of content server 410, central server 450, and user system 435 performs the recognition. In Rodkin, between the central server and content server, the content server is the only computer interacting directly with the client system--see, for example, Fig. 4, showing that user computer 435 is connected to content server 410. Rodkin expressly teaches that

recognition and annotation is performed by the intelligent annotator 412, 520, which is on the content server 410, not the central server.

To further emphasize the aforesaid limitations in Rodkin's teachings, new claim 67 is added, which is identical to claim 48, but with the language "wherein the computer code operates to recognize and annotate key elements in the document that were not previously recognized and/or annotated by the content provider providing the document to the client computer system." The amendment does not introduce any new matter and is fully supported by the specification (see, e.g., pages 30-36).

Claim 49 recites that the consumer computer receives code for performing annotation and recognition functions. The Action does not discuss this limitation specific to a consumer computer system. Rodkin teaches that annotation is performed by the content server, not the users computer system.

Claim 53 is amended to emphasize certain patentable distinctions. The amendment does not introduce any new matter and is fully supported by the specification (see, e.g., pages 30-36.) A similar amendment is made to claim 54.

Other claims under rejection are dependent claims that have one of the foregoing independent claims as a base claim. Given the foregoing reasons, if the independent claims are allowable then all dependent claims are necessarily also allowable over the cited art.

In view of the foregoing reasons that clearly distinguish the claims over the cited art, Applicant has not comprehensively stated every basis for overcoming the rejections of the Office Action. Applicant, however, reserves the right to do so at a later time. Therefore, nothing herein should be deemed as a disclaimer of any rights, an acquiescence in any rejection or a waiver of any arguments that might have been raised but were not raised herein or otherwise in the prosecution of this application.

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Information Disclosure Statement

Applicant understands that the Hori, et al. article submitted via an Information Disclosure Statement to the Patent Office in July, 2001 has not yet been considered by the Examiner. Copies of the Hori article and the original PTO Form 8A are attached. Applicant respectfully requests consideration of the article. Since this article was originally submitted in July, 2001, Applicant understands that no fees with regard to the duty of disclosure are due at this time.

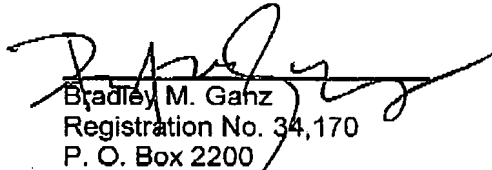
CONCLUSION

Applicant submits that in view of the foregoing remarks and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested.

The Commissioner is hereby authorized to charge any fees, including extension fees, or to charge any additional fees or underpayments, including extra claim fees, or to credit any overpayments, to the Credit Card account referenced on the accompanying Credit Card Payment form (PTO-2038). As an alternative, in case the Credit Card cannot be processed, the Commissioner is hereby authorized to charge any fees, additional fees, or underpayments, or to credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

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